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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/274,942	07/14/1994	PETER HAGMANN	CLV19623ACVE	2571

1095 7590 09/11/2003

THOMAS HOXIE  
NOVARTIS, CORPORATE INTELLECTUAL PROPERTY  
ONE HEALTH PLAZA 430/2  
EAST HANOVER, NJ 07936-1080

EXAMINER
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VARGOT, MATHIEU D

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 09/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

00/274,942

Applicant(s)

HAGMANN et al.

Examiner

M. VNR60T

Group Art Unit

1732

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

☒ Responsive to communication(s) filed on 6/30/03

☒ This action is **FINAL**.

- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

☒ Claim(s) 1-5, 8-40, 42-61 + 63-81

is/are pending in the application.

Of the above claim(s)

is/are withdrawn from consideration.

☐ Claim(s)

is/are allowed.

☒ Claim(s) 1-5, 8-40, 42-61 + 63-81

is/are rejected.

☐ Claim(s)

is/are objected to.

☐ Claim(s)

are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

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1. Claims 1-5, 8-40, 42-61 and 63-81 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has amended the independent claims to recite that the energy-impinging region has a “non-adjustable” peripheral boundary and that the starting material disposed in such region is caused to be crosslinked “all together”. There is no support for these recitations, particularly the former. Applicant can not rely upon the fact that simply because the instant disclosure does not teach an adjustable mask that therefore support exists for claiming a “non-adjustable” boundary. In essence, the instant language is akin to reciting a negative limitation, in that applicant is attempting to “get around” the disclosure of Clark by reciting something that Clark discloses but the instant does not. Negative limitations require clear support and applicant is required to show where in the specification as filed such exists or delete the language “non-adjustable”. Further, it is not believed that the language “all together” exists concerning the crosslinking of the starting material. Again, applicant is required to show where such language is or delete it from the claims.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-4, 8-40, 42-61 and 63-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark et al substantially for reasons of record as set forth in the Board decision, paper No. 20, mailed July 26, 2002.

In the event that support exists for the recitations submitted as new matter in paragraph 1, supra, it is submitted that they would have been obvious over the general method disclosed in Clark et al. Note that Clark et al does not have to use an adjustable opening--this is merely an additional embodiment. See column 7, line 25 (ie, the language "alternate" concerning the adjustable diaphragm). Removing the diaphragm entirely would not involve using an adjustable diaphragm, so the language "non-adjustable" would not define thereover. Also, see the top of column 8, lines 3+ in Clark et al, wherein processes involving an expansion of the polymerized material occurs. Any formation of a lens from this material would inherently involve a non-adjustable diaphragm and that the material be crosslinked "all together". Again, applicant is referred to the Board decision in which additional polymerization to form flash or burr outside the perimeter of the desired lens in Clarke et al was found to be a preferred embodiment of the applied reference and hence an obvious deletion if desired. Hence, the instant claims, even if supported by the instant specification, are submitted to nevertheless have been obvious over the applied reference for reasons already of record.

3. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clark et al and further in view of European Patent Application 484,015 for reasons of record.

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4. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

In view of the amendment, a 112 new matter rejection has been applied; the art rejection remains the same. Comments directed to Clarke et al not appreciating that the edge of the molding can be defined by the "non-adjustable" periphery of the energy impinging region have been addressed by the Board previously, except for the aspect of the periphery being "non-adjustable". It is submitted that applicant does not have support in the specification as originally filed to make this recitation. Further, even if such support does exist, the adjustability of the diaphragm in Clarke et al simply represents an additional embodiment which one of ordinary skill in this art would have found obvious to dispense with if such were not desired or needed.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

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will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Vargot whose telephone number is 703 308-2621.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0661.

M. Vargot

September 6, 2003

*M. Vargot*  
MATHIEU D. VARGOT  
PRIMARY EXAMINER  
GROUP 1300

9/6/03